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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/785,660

02/24/2004

Fabio Bastian

58479-59

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7590

06/05/2006

DAVIS WRIGHT TREMAINE, LLP  
2600 CENTURY SQUARE  
1501 FOURTH AVENUE  
SEATTLE, WA 98101-1688

EXAMINER

COULTER, KENNETH R

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/785,660	<b>Applicant(s)</b> BASTIAN ET AL.	
	<b>Examiner</b> Kenneth R. Coulter	<b>Art Unit</b> 2141	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 59-101 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 59-101 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/487,752.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)              |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/25/04; 6/30/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS; 2/24/04</u> .                      |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 59 – 101 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 43 of U.S. Patent No. 6,757,712. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the mapping detailed below.

Claim 59 of the present Application maps closely to claims 1, 13, 32, 33, 37, 38, 39, and 43 of '712.

Claim 60 of the present Application maps closely to claims 17 and 34 – 36 of '712.

Claim 61 of the present Application maps closely to claims 6, 17, and 36 of '712.

Claim 62 of the present Application maps closely to claim 29 of '712.

Claim 63 of the present Application maps closely to claim 30 of '712.

Claim 64 of the present Application maps closely to claim 31 of '712.

Claim 65 of the present Application maps closely to claims 7, 14, and 40 of '712.

Claim 66 of the present Application maps closely to claims 32, 37 – 39, and 43 of '712.

Claim 67 of the present Application maps closely to claims 37 – 39 of '712.

Claim 68 of the present Application maps closely to claim 38 of '712.

Claim 69 of the present Application maps closely to claims 9 and 18 of '712.

Claim 70 of the present Application maps closely to claims 10 and 19 of '712.

Claim 71 of the present Application maps closely to claim 21 of '712.

Claim 72 of the present Application maps closely to claim 22 of '712.

Claim 73 of the present Application maps closely to claim 25 of '712.

Claim 74 of the present Application maps closely to claim 26 of '712.

Claim 75 of the present Application maps closely to claim 27 of '712.

Claim 76 of the present Application maps closely to claim 28 of '712.

Claims 77 – 101 map similarly to the detailed mapping of claims 60 – 76 above.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 59 – 101 are rejected under 35 U.S.C. 102(e) as being anticipated by Leuca et al. (U.S. Pat. No. 6,449,287) (Short Messaging Method and System for Airborne Passengers).

4.1 Regarding claim 59, Leuca discloses a system for transmitting electronic data between a terrestrial base station and a plurality of passenger computer terminals coupled to a network on an aircraft, the system comprising:

a storage device to store e-mail messages for the plurality of passenger computer terminals (Fig. 1; Abstract “The messages are **stored** on the aircraft until sufficient bandwidth becomes available for transmission to the ground.”; col. 1, lines 53 – 57 “a **memory device** that stores messages when communication bandwidth is unavailable”); and

a server secured to the aircraft and coupled to the storage device and to the plurality of passenger computer terminals via the network, wherein the server and storage device are configured to collect and store a plurality of e-mail messages from the plurality of passenger computer terminals irrespective of whether or not communication bandwidth is available, the server being further configured to establish

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an intermittent wireless link with the base station to transmit the plurality of stored e-mail messages as a group over the link to the base station when the aircraft is in flight and when the server determines to initiate the transmission (Abstract; Fig. 2, item 25; col. 1, lines 53 – 61 “An air-to-ground telecommunications system allows callers to **store messages on an aircraft data server** when sufficient air-to-ground communication bandwidth is unavailable for transmitting a call. The system allows aircraft callers to leave voice, fax, **e-mail** or other data messages.”).

4.2 Per claim 60, Leuca teaches the system of claim 59 wherein the base station stores electronic data to be transmitted from the base station to the server, and the server stores electronic data to be transmitted from the server to the base station, wherein the server and base station communicate with each other intermittently, and wherein the server determines when to transmit the stored data on the basis of the amount of time the aircraft has been in flight or on the basis of an amount of data stored (Fig. 2, item 25; Abstract “Messages are stored on the aircraft until **sufficient bandwidth becomes available** for transmission to the ground.”).

4.3 Regarding claim 61, Leuca does not explicitly disclose the system of claim 60 wherein the base is configured to generate a trigger signal between the base station and the server when a predetermined amount of data has been stored by the base station, to initiate transmitting of the stored data to the server.

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However, due to the intermittent and high cost of transmitting information between an aircraft server and the ground, it is inherent to store the data on the ground until it is efficient to transmit that data to the aircraft server. Maintaining a constant connection from the aircraft to the ground would be more expensive than periodically connecting when a certain amount of data has been accumulated.

4.4 Per claim 62, Leuca teaches the system of claim 59 wherein the base station selectively communicates with an Internet service provider (ISP) or corporate private network to collect data and provide it to the passenger computer terminals via the server (Fig. 1; col. 2, lines 53 – 65).

4.5 Regarding claims 63 and 64, Leuca does not explicitly disclose the specific features involving resending email and deleting email messages.

However, these specific email features are commonplace in electronic mail sending and receiving systems. It would have been inherent to implement these features in Leuca because these features are commonplace user friendly email features.

4.6 Per claim 65, Leuca does not explicitly teach that the server and storage device store e-mail messages transmitted to the aircraft over the wireless link for at least one of the plurality of passengers, despite the one passenger's computer terminal not being logged into the server over the network.

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However, it is commonplace (and almost universal) for a local server to store incoming email for users who may or may not be currently logged onto the local network.

Therefore, for convenience to the passengers who are not continuously logged onto the aircraft network, the aircraft server and database would store incoming email.

4.7 Regarding claims 66 – 70, Leuca does not explicitly disclose the specific features involving resending email and deleting email messages.

However, these specific email features are commonplace in electronic mail sending and receiving systems. It would have been inherent to implement these features in Leuca because these features are commonplace user friendly email features.

4.8 Per claims 71 – 76, Leuca does not explicitly teach the particular features related to web page updating, communication among airplane passengers, searching and accessing web pages, or proxy cache operations.

However, these specific web page accessing features are commonplace in electronic mail sending and receiving systems. It would have been inherent to implement these features in Leuca because these features are commonplace user friendly web page accessing features.

4.9 Regarding claims 77 – 101, the rejection of claims 59 – 76 under 35 USC 102(e) (paragraphs 4.1 – 4.8 above) applies fully.



***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 59 – 101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinberger (U.S. Pat. No. 6,499,027) (System Software Architecture for a Passenger Entertainment System, Method and Article of Manufacture) in view of Leuca et al. (U.S. Pat. No. 6,449,287) (Short Messaging Method and System for Airborne Passengers).

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6.1 Regarding claim 59, Weinberger discloses a system for transmitting electronic data between a terrestrial base station and a plurality of passenger computer terminals coupled to a network on an aircraft, the system comprising:

a storage device to store e-mail messages for the plurality of passenger computer terminals (Abstract; Fig. 3, item 268); and

a server secured to the aircraft and coupled to the storage device and to the plurality of passenger computer terminals via the network (Abstract; Fig. 3, item 268; Fig. 2, item 320).

However, Weinberger does not explicitly disclose the server and storage device are configured to collect and store a plurality of e-mail messages from the plurality of passenger computer terminals irrespective of whether or not communication bandwidth is available, the server being further configured to establish an intermittent wireless link with the base station to transmit the plurality of stored e-mail messages as a group over the link to the base station when the aircraft is in flight and when the server determines to initiate the transmission.

Leuca discloses disclose the server and storage device are configured to collect and store a plurality of e-mail messages from the plurality of passenger computer terminals irrespective of whether or not communication bandwidth is available, the server being further configured to establish an intermittent wireless link with the base station to transmit the plurality of stored e-mail messages as a group over the link to the base station when the aircraft is in flight and when the server determines to initiate the

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transmission (Abstract; Fig. 2, item 25; col. 1, lines 53 – 61 “An air-to-ground telecommunications system allows callers to **store messages on an aircraft data server** when sufficient air-to-ground communication bandwidth is unavailable for transmitting a call. The system allows aircraft callers to leave voice, fax, **e-mail** or other data messages.”).

It would have been obvious to one of ordinary skill in the art at the time of the invention to store email information on the aircraft until the server determines a judicious time for transmission because, due to the intermittent and high cost of transmitting information from an aircraft server and the ground, it is inherent to store the data on the aircraft until it is efficient to transmit that data to the ground. Maintaining a constant connection from the aircraft to the ground would be more expensive than periodically connecting when there has been enough time for a certain amount of data to be accumulated, compressed, and/or encrypted.

6.2 Per claim 60, Weinberger does not explicitly teach the system of claim 59 wherein the base station stores electronic data to be transmitted from the base station to the server, and the server stores electronic data to be transmitted from the server to the base station, wherein the server and base station communicate with each other intermittently, and wherein the server determines when to transmit the stored data on the basis of the amount of time the aircraft has been in flight or on the basis of an amount of data stored.

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Leuca teaches the system of claim 59 wherein the base station stores electronic data to be transmitted from the base station to the server, and the server stores electronic data to be transmitted from the server to the base station, wherein the server and base station communicate with each other intermittently, and wherein the server determines when to transmit the stored data on the basis of the amount of time the aircraft has been in flight or on the basis of an amount of data stored (Fig. 2, item 25; Abstract "Messages are stored on the aircraft until **sufficient bandwidth becomes available** for transmission to the ground.").

It would have been obvious to one of ordinary skill in the art at the time of the invention to store email information in the base station until the server determines a judicious time for transmission because, due to the intermittent and high cost of transmitting information from an aircraft server and the ground, it is inherent to store the data in the base station until it is efficient to transmit that data to the aircraft. Maintaining a constant connection from the aircraft to the ground would be more expensive than periodically connecting when there has been enough time for a certain amount of data to be accumulated, compressed, and/or encrypted.

6.3 Regarding claim 61, Weinberger does not explicitly disclose the system of claim 60 wherein the base is configured to generate a trigger signal between the base station and the server when a predetermined amount of data has been stored by the base station, to initiate transmitting of the stored data to the server.

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However, due to the intermittent and high cost of transmitting information between an aircraft server and the ground, it is inherent to store the data on the ground until it is efficient to transmit that data to the aircraft server. Maintaining a constant connection from the aircraft to the ground would be more expensive than periodically connecting when a certain amount of data has been accumulated.

6.4 Per claim 62, Weinberger teaches the system of claim 59 wherein the base station selectively communicates with an Internet service provider (ISP) or corporate private network to collect data and provide it to the passenger computer terminals via the server (Fig. 1, item 113; col. 5, line 66 – col. 6, line 15).

5.5 Regarding claims 63 and 64, Weinberger does not explicitly disclose the specific features involving resending email and deleting email messages.

However, these specific email features are commonplace in electronic mail sending and receiving systems. It would have been inherent to implement these features in Weinberger because these features are commonplace user friendly email features.

6.6 Per claim 65, Weinberger does not explicitly teach that the server and storage device store e-mail messages transmitted to the aircraft over the wireless link for at least one of the plurality of passengers, despite the one passenger's computer terminal not being logged into the server over the network.

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6.7 Regarding claims 66 – 70, Weinberger does not explicitly disclose the specific features involving resending email and deleting email messages.

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6.8 Per claims 71 – 76, Weinberger does not explicitly teach the particular features related to web page updating, communication among airplane passengers, searching and accessing web pages, or proxy cache operations.

However, these specific web page accessing features are commonplace in electronic mail sending and receiving systems. It would have been inherent to implement these features in Weinberger because these features are commonplace user friendly web page accessing features.

6.9 Regarding claims 77 – 101, the rejection of claims 59 – 76 under 35 USC 103(a) (paragraphs 6.1 – 6.8 above) applies fully.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Carpenter et al. U.S. Pat. No. 5,859,973 Methods, System and Computer Program products for Delayed Message Generation and Encoding in an Intermittently Connected Data Communication System

A message generating system in an intermittently connected communication system.

Taylor et al. U.S. Pat. No. 6,643,510 Mobile Platform Real Time Availability and Content Scheduling System and Method

A mobile platform (aircraft) system that allows email access (filed 8/29/01).

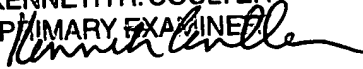
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KENNETH R. COULTER  
PRIMARY EXAMINER



krc